REMARKS

INTRODUCTION

In accordance with the following, reconsideration of the allowability of the pending claims is respectfully requested.

Claims 1-20 are pending and under consideration.

REQUEST FOR NEW OFFICE ACTION

The rejections of claims 6 and 17 are based upon the additional reference Jeon et al., U.S. Patent No. 6,014,178, while Jeon et al. is not a proper reference under 35 USC 103(c).

Similarly, the rejection of claims 18-20 make reference to Jeon et al., while the corresponding rejection preamble only refers to Devaney, U.S. Patent No. 6,357,045; and Cummins, U.S. Patent No. 5,784,120, i.e., it would appear that at least this rejection of claims 18-20 would appear to be in error.

Regarding Jeon et al., as noted in the Request for Withdrawal of Finality filed July 20, 2006, the contents of which are incorporated herein, Jeon et al. is not a proper reference. Here, the Office Action's statement that Jeon et al. is a proper reference is incorrect and the corresponding rejections that rely upon Jeon et al. are similarly improper. See MPEP 2146, which states that for all applications (including reissue applications), if the application is pending on or after December 10, 2004, the 2004 changes to 35 U.S.C. 103(c), which effectively include the 1999 changes, apply; "thus, the November 29, 1999 date of the prior revision to 35 U.S.C. 103(c) is no longer relevant."

Accordingly, if claims 6 and 17 and 18-20 are being rejected based upon a modification of Jeon et al., it is respectfully submitted that these rejections are improper.

Thus, as the outstanding Office Action is improper, at least for the rejections of claims 6 and 17-20, withdrawal of these rejections is respectfully requested.

REJECTION UNDER 35 USC 103

Claims 1-5 and 7-16 stand rejected under 35 USC 103 as being obvious over Bestler et al., U.S. Patent No. 5,638,112, in view of Cummins et al., U.S. Patent No. 5,784,120, and Devaney, U.S. Patent No. 6,357,045. This rejection is respectfully traversed.

In response to applicants previous remarks that the previous Office Action appeared to have treated claims 1, 5, and 11 as having similar scope and breadth, while applicants noted that each of claims 1, 5, and 11 set forth separately differentiating features and aspects not disclosed or suggested by the relied upon references, or combination thereof, the outstanding Office Action has merely responded to applicants' more detailed Office Action request with two brief comments.

First, the Office Action set forth that the claimed encoding of a predetermined additional information according to an extracted synchronous signal would have been met by a further modification of the primary reference or would have been met upon the primary reference being modified to perform another modified feature.

Secondly, the Office Action set forth that applicants comments, that the ADC conversion of Cummins et al. is unrelated to an encoding of additional information, were not persuasive because Cummins et al. shows "that after processing, the video signals (Y-U-V format), are then passed along to the video encoder, to be displayed on the screen. The H-sync & V-sync signals are passed along to the Timing generator. Thus by combining Bestler with Cummins, the claimed subject matter is met."

However, again, this brief response fails to particularly explain how the primary reference would be modified to perform the underlying claimed feature, or what in the secondary reference would either provide that claimed feature or would support the addition of the same to Bestler et al.

Rather, the Office Action only briefly concludes that upon addition of a feature from Cummins et al. to Bestler et al. the remaining unmentioned features would merely follow. Applicants respectfully submit that this is improper.

It is respectfully submitted that each and every feature in each claim must be addressed and a prima facie obviousness case must be made for each feature not present in the primary reference. The combination of one feature from a secondary reference into a primary reference does not mean that each and every feature from the secondary reference inherently follows.

Further, it is further submitted that regardless of the opinion of the Examiner that a primary reference may be modified to meet one missing feature, more than a conclusory statement is required as to why the modified primary reference would further perform/accomplish another missing feature or why that additional feature would have been obvious.

For example, the Office Action set forth that Bestler et al. fails to disclose the claimed extracting of the synchronous signal, and thereafter uses Cummins et al. to disclose the same.

Here, Cummins et al. merely discusses a method for using an extracted synchronous signal during a re-sampling in an Analog-to-Digital (ADC) conversion of an input analog video signal, i.e., Cummins et al. discuses a method of ensuring that an input analog signal is properly A/D converted.

For this use of the synchronous signal, the only correlation to Bestler et al. would appear to be when the analog video is converted to digital form in A/D converter 74.

Thus, the teaching of Cummins et al. to extract a synchronous signal from an analog signal would only appear relevant to a minor portion of Bestler et al., after the analog broadcast composite video has been decoded to analog broadcast YUV signals and during the digitizing of the analog broadcast YUV signals, before any interaction with any additional information. **Briefly, the Office Action's reliance on the extraction of a synchronous signal for improved A/D conversions to avoid "jitters" in an A/D circuit is not the same "jitters" as discussed in the present application when switching between analog and digital sources, i.e., different solutions are being presented for different problems even though a similar "jitter" term is used.**

Accordingly, the Office Action states that Cummins et al. teaches: "separating the horizontal sync or vertical sync signals from the incoming broadcast signal, and using this information to adjust the signal to a digital form;" and extrapolates from this interpretation that it would have been obvious to modify Bestler et al. to do the same.

Regardless of an obviousness of modifying the A/D converter 74 of Bestler et al., apparently based upon this teaching of Cummins et al., the Office Action (as recited on page 2 of the Office Action) attempts to either further modify Bestler et al. or argues that such a modification would result in the claimed encoding of the additional information according to the extracted synchronous signal. Particularly, the Office Action points to the CV encoder 80 of Bestler et al. generating a corresponding NTSC format analog composite video baseband output signal, and states "[t]hus the combination of Cummins (which teaches extracting

synchronous data from a video signal, col. 4, lines 45-67) with Bestler meets the claimed feature."

Therefore, in this example, the Office Action has relied upon Cummins et al. to support a modification of Bestler et al. to extract a synchronous signal for better A/D conversion of analog signals, and then broadens the use of the synchronous extraction to argue that un-related portion of Bestler et al. would now use that extracted synchronous signal. Above, the CV encoder 80 is unrelated to the A/D converter 74, and any use of an extracted synchronous signal by A/D converter 74 (for the use taught by Cummins et al.) would not have any relationship to any workings of encoder 80, i.e., just because the synchronous signal is extracted does not mean that any alternate use of the synchronous signal is obvious or derives from the same modification.

Here, is if further noted that the Office Action's reference to CV encoder 80 and any teaching of extracting a synchronous signal by Cummins et al. is still unrelated to the claimed encoding of additional information.

The teaching of Cummins et al. is unrelated to encoding of additional information and the proffered further modification of Bestler et al. to include the same is not supported in the record by evidenced motivation.

As noted in the previous response, to disclose the claimed transmitting of the predetermined additional information overlapped with the analog broadcasting signal, the Office Action further relies upon Devaney, citing a portion of Devaney that discusses overlaying caption information overlaid on scenes.

However, similar to above, Devaney would not appear to discuss the overlaying of encoded predetermined additional information when an analog broadcasting signal is selected. Devaney would appear to be focused primarily on digital broadcasting signals.

In addition, Devaney similarly would appear to fail to disclose or suggest that such additional information encoding was performed based upon an extracted synchronous signal from the analog broadcasting signal. See Devaney in col. 4, lines 5-12, which would appear to support Devaney actually teaching away from such encoding of additional information.

Here, in addition to failing to address these missing features or provide the evidenced motivation for modifying Bestler et al., it is further respectfully submitted that the underlying

references fail to disclose or suggest at least the claimed encoding of the additional information or the transmitting of the additional information.

Regarding dependent claims 2, for example, the Office Action briefly states that Bestler et al. already discloses the claimed features of analogizing the MPEG processed video signal and the additional information for the digital signal or only analogizing the additional information for the analog broadcast signal, referencing col. 4, lines 20-30.

However, Bestler et al. would appear to convert any signal provided to third IC 78, regardless of whether it was originally an analog signal or digital signal, resulting in there being no difference in the analogizing of signals.

Similar to above, regarding independent claims 5 and 11, none of Bestler et al., Cummins et al., or Devaney disclose or suggest extracting a synchronous signal from an analog broadcasting signal and then using that extracted synchronous signal during a video encoding of an MPEG processed video signal and additional information, as set forth in claim 5, or encoding the video signal from the digital broadcasting signal and the additional information based on the extracted synchronous signal, as set forth in claim 11.

In the Office Action, the rejection of independent claim 5 does not appear to have addressed these previous remarks, and merely sets forth features believed to be disclosed by Bestler et al.

Though claims 5 and 11 are independent claims, the Office Action has not set forth any obviousness remarks or pointed out what features are not disclosed by Bestler et al. For missing features the Office Action it is believed that the Office Action is relying upon the obviousness comments for the rejection of claim 1, even though the different claims set forth the claimed invention differently, with different scope.

Therefore, for at least the above, it is respectfully requested that this rejection of claims 1-5 and 7-16 be withdrawn.

Claims 6 and 17 stand rejected under 35 USC 103 as being obvious over Bestler et al., Cummins et al., and Devaney, in view of Jeon, and claims 18-20 apparently stand rejected under 35 USC 103 as being obvious over Devaney, in view of Cummins et al.. These rejections are respectfully respected.

As noted above, Jeon and the present application have the same assignee. As Jeon can only be a reference under 35 USC 102(e), this reference cannot be used in a 35 USC 103 rejection under 103(c).

With regard to claims 18-20, and similar to above, the Office Action has expanded the teaching of Cummins et al. to essentially mean the application of an extracted synchronous signal for any use, stating that Cummins et al. "teaches a method of extracting synchronous data from a video signal...." and arguing that such a teaching supports a modification of Jeon (potentially a typographical error meant to mean Devaney) to extract horizontal sync or vertical sync pulses from an analog input signal "for the well known benefits for avoiding overflow of video into buffers, which prevents distortion."

However, again, there is no support in the record as to how an improvement of an A/D converter for an analog signal, e.g., A/D converter 74 in Bestler et al., would have any relevance to applying the synchronous signal of the analog signal to synchronizing digital and analog signals upon switching between sources.

Therefore, withdrawal of these rejections is respectfully requested.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

Date: November 13, 2006 By: _____

Stephen T. Boughner
Registration No. 45,317

1201 New York Avenue, NW, 7th Floor
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501